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on 28 July 2000 by Jeffrey B. Ostler
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Joni Kristin Doherty, Gail M. Clinton and John P. Adelman

Serial No.: 09/234,208

Filed: 20 January 1999

For: HER-2 BINDING ANTAGONISTS

Examiner: J. Hunt

Art Unit: 1642

Docket No.: 49321-1

Date: 28 July 2000

#12
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8-11-00

Box Non Fee Amendment
Assistant Commissioner for Patents
Washington, DC 20231

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This is in response to a Restriction Requirement dated 29 March 2000 for the above-identified patent application. Kindly extend the time for response three months, up to an including 31 July 2000. A request for a three month extension of time is provided.

REMARKS

Applicants respectfully request reconsideration of the restriction requirement in view of the following remarks. Applicants elect Group I with traverse.

Applicants respectfully traverse this restriction requirement in that it should be drawn to two groups instead of five groups. The two groups should be Group A composed of the groups I and III-V and Group B composed of group II with claim 7 (transfected cell) transferred to Group A.

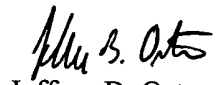
The present restriction imposes an undue burden on applicants to have to file multiple divisional patent application and thousands of dollars in extra fees alone just to be able to claim the full scope of a single invention based upon a single laboratory discovery that has multiple

product related implications. Although the division of subject matter as between DNA (and the transfected cell) expressing a particular polypeptide has long been divided, the reason of different chemical structures (oligonucleotide versus polypeptide) is really a poor excuse to divide because the purpose of the oligonucleotide is to express the polypeptide. While applicants realize the real reason is the convenience of the structure of the art units as organized at the PTO, nevertheless, it imposes an undue burden on applicants to file multiple divisional patent applications and pay multiple maintenance fees for a single invention just to obtain a full scope of protection. Similar fictions of division are not present in other countries, such as the European Patent Office who do not divide the subject matter of a DNA sequence and the expressed polypeptide. While applicants realize this form of restriction has become routine at the United States PTO, applicants wish to so note their complaint due to its scientific illogic.

Separating Groups III-V requires more of a logic stretch to implement. Claims 14-26 should be in a single group. Certainly the PTO needs to get away from the mentality that each "invention" can be claimed by more than one independent claim. Why is the fee structure built upon three independent claims (before additional fees are due) if the practice of the Group 1600 art units is one independent claim per restricted group? The Examiner indicates that these three claim groups require an independent search. However, the enabling disclosure in the specification is not so structured and the searched compound element of each claim is the same. A single, broader search will suffice for groups III-V and it is the same search for group I. Therefore, allowing for the historical PTO art unit split as between polypeptides and oligonucleotides, the present invention should be drawn as between Group A and Group B with applicants electing Group A.

Applicants respectfully request examination and consideration of claims 1-3, 7-10 and 14-26.

Respectfully submitted,



Jeffrey B. Oster
Attorney for Applicants
Registration No. 32,585

Davis Wright Tremaine
2600 Century Square
1501 Fourth Avenue
Seattle, Washington 98101
Telephone (206) 628-7711
Facsimile (206) 628-7699